

REMARKS

In response to the Office Action mailed December 17, 2010, Applicant respectfully requests reconsideration and reexamination of this application, withdrawal of the rejections outlined below, and the timely allowance of the pending claims.

I. Status of the Claims

Claims 35-37, 40-42, 44-63, and 65-78 are pending and examined in this application. Without prejudice or disclaimer, claims 35 and 78 are amended. Exemplary support for the amendments of claims 35 and 78 can be found throughout the specification as-filed. In addition, claims 36, 50, 51, and 67 are amended to correct informalities pointed out in the Examiner's objection. Accordingly, no issue of new matter or written description is raised by this amendment.

II. Objections

The Examiner's objection to claims 50 and 51 as having space within a number is acknowledged and is corrected in the amendment. The Examiner's objection to claim 67 lacking a period at the end of a claim sentence is acknowledged and is corrected in the amendment.

III. Rejection of Claims under 35 U.S.C. §103

A. Claims 35-37, 40-42, 44-63, 65-76 and 78

Claims 35-37, 40-42, 44-63, 65-76, and 78 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over EP 1034776 A1 to Tournilhac ("Tournilhac") in view of WO 01/19333 in view of Bitler ("Bitler") as evidenced by U.S. Patent No. 5,156,911 ("Stewart") for the reasons set forth in pages 3-11 of the Office Action. Specifically, the Office contends that Tournilhac "teaches a cosmetic composition comprising olefin polymers which do not migrate over skin surface, present a glossy appearance, resists water and stays on throughout the day." Office Action at 4 (citations omitted). The Office further contends that "Tournilhac teaches that the compositions comprise a liquid fatty phase and a semi-crystalline olefin (i.e. crystallinity from 5 to 40%)(¶ 0010)." *Id.* at 4, 7. The Office alleges that "Tournilhac, while teaching a high melting polymer (150 degrees Celsius or less), does appear to explicitly disclose use of a semi-crystalline homopolymer or copolymer having a melting point of less than 50 degrees Celsius." *Id.* at 7.

Applicant respectfully disagrees and traverses the rejection for the reasons of record. However, by this Amendment, the Applicant has amended independent claims 35 and 78, which are the only independent claims included in this claim rejection. Applicant respectfully submits that a prima facie case of obviousness with respect to the subject matter recited in amended independent claims 35 and 78 has not been established, for the reasons below.

The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 415-419, 82 U.S.P.Q.2d 1385, 1395-97 (2007) identified a number of rationales to support a

conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). As stated in the 2010 KSR Guidelines Update, “merely pointing to the presence of all claim elements in the prior art is not a complete statement of a rejection for obviousness.” 75 Fed. Reg. 53643, 53647 (Sept. 1, 2010) (discussing *Crocs, Inc. v. U.S. Int’l Trade Comm’n*, 598 F.3d 1294, 1309-10 (Fed. Cir. 2010).) A proper rejection based on the rationale that the claimed invention is a combination of prior art elements also includes a finding that results flowing from the combination would have been predictable to a person of ordinary skill in the art. *Id.* Predictability as discussed in *KSR* encompasses not only the expectation that prior art elements are capable of being physically combined, but also that the combination would have worked for its intended purpose. *Id.* at 53649. Thus, by its very nature, an obviousness rejection is based on the assumption that similar compositions will exhibit similar properties.

A composition according to the presently amended claims, requires “a mixture of at least one semi-crystalline polymer having an organic structure selected from low-melting polymers having a melting temperature of less than 50° C, and at least one semi-crystalline polymer having an organic structure selected from high-melting polymers having a melting temperature of at least 50° C, wherein said semi-crystalline polymers are side chain crystallizable polymers.” Tournilhac fails to teach “at least one semi-crystalline polymer having an organic structure selected from high-melting polymers having a melting temperature of at least 50°C” that is also “a side-chain crystallizable polymer.”

The Office alleges that “Tournilhac, while teaching a high melting polymer (150 degrees Celsius or less), appears to explicitly disclose use of a semi-crystalline homopolymer or copolymer having a melting point of less than 50 degrees Celsius.” Office Action at 7. Even if Tournilhac disclosed a semi-crystalline high melting polymer as alleged by the Office, Tournilhac fails to disclose a semi-crystalline high melting polymer that is also “a side chain crystallizable polymer.”

As shown in the Declaration under 37 C.F.R. § 1.132 of Frédéric Auguste dated May 17, 2011 (“Auguste Declaration”), submitted herewith, the composition made with main chain semi-crystalline polymer, as taught by Tournilhac, displays a high level of transfer that differs substantially from the non-transferability exhibited by compositions made according to the present claims. See Auguste Declaration ¶¶ 15-19. The Auguste Declaration demonstrates that the composition taught by Tournilhac using a main chain crystallizable polymer exhibits a 93% transfer rate. See *id.* This is in sharp contrast with the 33% transfer rate achieved by using at least one high melting point side chain crystallizable semi-crystalline polymer and at least one low melting point side-chain crystallizable semi-crystalline polymer in composition 1 made according to the present application. See *id.* Nothing in Tournilhac or Bitler suggest that specific selection of the elements and compositions as presently set forth in the amended claims would result in the increase in transfer resistance as shown in the Auguste Declaration. Therefore, such unpredicted results further evidence that the presently claimed is evidence that the composition is not obvious over the cited references. See ¶ 20.

It is well established that an invention cannot be obvious if it yields unpredictable results. See M.P.E.P. § 2143 and 2010 KSR Guidelines Update (“a proper rejection

based on the rationale that the claimed invention is a combination of prior art elements also includes a finding that the results flowing from the combination would have been predictable to a person of ordinary skill in the art.”) 75 Fed. Reg. at 53647. The Auguste Declaration demonstrates that a person of ordinary skill in the art would not have predicted the improved properties of the claimed compositions, and would not have had a reasonable expectation of success in arriving at the claimed compositions. Auguste Declaration ¶ 20.

The Office further alleges that it would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Tournilhac with the side chain crystalline polymers thickeners of Bitler. See Office Action at 9. The Office also notes that “one would have been motivated to do so because Tournilhac teaches the oil-containing cosmetic composition of its invention can beneficially include another semi-crystalline polymer [...] and Bitler teaches that the SCC polymers (1) [are] usable in two or more SCC polymer combinations, (2) are effective thickeners for oil-containing compositions, and furthermore (3) reduce or remove the need to use surfactants which can cause adverse reactions when in contact with human skin.” *Id.* at 9-10 (internal citations omitted). Applicant respectfully disagrees and points out that Bitler mentions in several places that it is undesirable to have the temperature of the polymers be too far above the temperature of use. See Bitler at p. 6, ll. 22-28; p. 9, ll. 5-9. Thus, it is unlikely that one skilled in the art would have chosen to combine the polymers taught by Bitler with high-melting polymers. A claimed combination of prior art elements may be non-obvious where the prior art

teaches away from the claimed combinations and the combination yields more than predictable results. 75 Fed. Reg. 53643, 53647 (Sept. 1, 2010) (discussing *Crocs, Inc. v. U.S. Int'l Trade Comm'n*, 598 F.3d 1294, 1309-10 (Fed. Cir. 2010).) As previously discussed and shown in the Auguste Declaration, the composition according to the present claims leads to unpredictable results. Moreover, Bitler discourages and teaches away from using crystalline polymers with high melting temperatures. For instance, Bitler states that "the Tp of the thickening polymer is preferably 10-40°C above, particularly 10-30°C above, especially about 20°C above, the temperature at which the composition is to be used." Bitler at 6. "Thus for compositions to be used at 20-25°C, the thickening polymer preferably has a Tp of above 40°C, preferably 40-50°C. On the other hand, if the Tp of the thickening polymer is too far above the temperature of use, this can result in excessive crystallization and then precipitation of the polymer, thus reducing the thickening effect." *Id.* In Table 1, Bitler evaluated the effectiveness of the polymers as thickeners by testing the molecular weight, Tp, and viscosity of each sample. Bitler at p. 8. In Example 2, Bitler evaluated a polymer having a Tp of 67°C, outside the preferred 40-50°C, and concluded that this Tp resulted in excessive crystallinity and poor thickening, both undesirable results under the teaching of Bitler. Bitler at p. 9. The present claims require "at least one semi-crystalline polymer having an organic structure selected from high-melting polymers having a melting temperature of at least 50° C." Consequently, the Office has failed to establish why one of skill in the art would combine the polymers taught by Bitler with high melting semi-crystalline polymers. Because the Office has failed to establish a prima facie case of obviousness, Applicant respectfully requests withdrawal of this rejection.

B. Claims 35, 76, and 77

Claims 35, 76, and 77 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over” EP 1034776 A1 to Tournilhac in view of WO 01/19333 in view of Bitler as evidenced by Stewart in further view of Freund et al. (“Parafin Products: Properties, Technologies, Applications published in 1998) for reasons as set forth at pages 11-12 of the Office Action. Applicant respectfully disagrees and traverses for the following reasons.

The Office relies on Freund for teaching that the hardness of lipstick can be varied by the inclusion of carnauba wax. Office Action at 11. However, as discussed above, neither Tournilhac nor Bitler provides motivation to use a semi-crystalline high melting point polymer that is “side chain crystallizable.” Furthermore, none of the cited references provides motivation to combine the high-melting-point and low-melting-point polymers. Because Freund fails to disclose either one of these elements, it cannot remedy the aforementioned deficiencies. Accordingly, this rejection is in error and should be withdrawn.

Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 17, 2011 By:

A handwritten signature in cursive script, reading "David S. Forman".

David S. Forman
Reg. No. 33,694